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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,006	12/16/2003	Judith D. Auslander	F-755	4539

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EXAMINER	
ROGERS, SCOTT A	

ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/737,006	AUSLANDER ET AL.	
	Examiner	Art Unit	
	Scott A. Rogers	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/26/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☒ Other: *Detailed Action*.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-7, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanioka et al (US 6078682 A) in view of Yoshinaga et al (US 5763891 A) and Crandall (US 4857955 A).

Referring to claim 1:

Tanioka et al disclose a method for embedding key information into a printed document comprising the steps of creating a first section (the image) comprising a first ink having a first color under white light and creating a second section (the specific pattern) comprising a second different ink, wherein the second ink has a second color under white light which is substantially the same as the first color and has a different characteristic when subjected to invisible light, and wherein the first section and the second section are visually indiscernible from each other on the printed document in white light. See abstract and summary.

Tanioka et al do not teach that the second different ink comprises a fluorescent ink, wherein the fluorescent ink has a fluorescence when subjected to fluorescent-

exciting radiation. However, Yoshinaga et al teaches the use of such a fluorescent ink. See abstract and summary.

It would have been obvious to one of ordinary skill in the art to have modified Tanioka et al in view of Yoshinaga et al to have used a second different ink comprises a fluorescent ink in order to take advantage of a readily available and commonly used fluorescent inks for non-visualized information recording which can be cheaply and reliably discriminated by readily available and commonly used light sources.

Tanioka et al also do not teach the second section comprising key information, which is selected or highlighted by a user during creation of the document, and the first section comprises non-selected information. However, Crandall teaches such highlighting of selected information. See col. 5, lines 6-21.

It would have been obvious to one of ordinary skill in the art to have modified Tanioka et al in view of Crandall to have included means for a user to select or highlight key information during creation of the document in a section of the document including non-selected information in order to enable a user to make variable data in a document readily identifiable.

Referring to claim 2:

Crandall discloses the key information being selected or highlighted using word processing.

Referring to claim 3:

Crandall discloses the printed document is a word document printed on paper, while Tanioka et al and Yoshinaga et al disclose an image including symbols, patterns,

or identification marks. In the combination, the second section comprises words and symbols.

Referring to claim 5:

Tanioka et al disclose the first and second sections each comprise a black color ink. See col. 6, lines 9-27.

Referring to claims 6-7:

Yoshinaga et al disclose the feature using a plurality of different fluorescent inks for the identification mark or key information (the second section), wherein the second section thus comprises invisible ink forming the non-visualized identification mark or key information. See abstract and col. 2, lines 21-30.

Referring to claim 23:

The combination of Tanioka et al, Yoshinaga et al, and Crndall, as explained above with respect to claim 1, disclose a printed word processing document comprising: a first section comprising a first ink having a first color under white light; and a second section comprising a second different ink, wherein the second ink comprises a fluorescent ink and has a second color under white light which is substantially the same as the first color, wherein the luorescent ink has a fluorescence when subjected to fluorescent-exciting radiation, and wherein the first section and the second section are visually indiscernible from each other on the printed word processing document in white light, the second section comprising key information, which is selected or highlighted by a user during creation of the document by word processing, and the first section comprises non-selected information.

Claims 9, 12-15, 16, 19-22, 24, 26-28, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanioka et al (US 6078682 A) in view of Yoshinaga et al (US 5763891 A) and well known prior art (Official Notice).

Referring to claim 9, 16, 24, and 38:

Tanioka et al and Yoshinaga et al, as explained above with respect to claim 1, disclose a method and system for extracting key information comprising the steps and elements for subjecting a printed document to a first image scanning responsive to visible light for acquiring a first image of a first section for providing a first signal indicative of the first image and subjecting the printed document to a second image scanning responsive to fluorescent emission for acquiring a second image of a second section for providing a second signal indicative of the second image. In Tanioka et al, also note col. 2, lines 27-32 regarding the scanner.

Tanioka et al and Yoshinaga et al do not disclose the printed document being scanned into an electronic archival system with key information of the second section being detected, extracted and indexed so that the scanned document can be retrieved based on the key information. However, such archival systems are well known in the prior art. That is, archival systems that detected and extracted key information from sacnned documents and then use this key information to index the archived scanned document so it can be retrieved based on the key information.

It would have been obvious to one of ordinary skill in the art to have modified Tanioka et al in view and Yoshinaga et al to have applied their method and system for

extracting key information, as discribed above, in an archival system well known in the prior art, as disctribed above, in order to quickly and automatically archive scanned documents reducing operator archiving costs and errors and allowing easy and accurate document retrival in a sort time.

Referring to claims 12, 19, and 26:

Tanioka et al disclose the first and second sections each comprise a black color ink. See col. 6, lines 9-27.

Referring to claims 13-14, 20-21, and 27-28:

Yoshinaga et al disclose the feature using a plurality of different fluorescent inks for the identification mark or key information (the second section), wherein the second section thus comprises invisible ink forming the non-visualized identification mark or key information. See abstract and col. 2, lines 21-30.

Claims 10-11, 17-18, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanioka et al and Yoshinaga et al, as applied respectively to claims 9 and 16 above, and further in view of Crandall.

Referring to claims 10 and 17:

Crandall discloses the key information being selected or highlighted using word processing as explained above with respect to claims 1 and 2.

Referring to claims 11 and 18:

Yoshinaga et al teache that the second different ink comprises a fluorescent ink, wherein the fluorescent ink has a fluorescence when subjected to fluorescent-exciting radiation as explained above with respect to claim 1.

Referring to claim 25:

Crandall discloses the printed document is a word document printed on paper, while Tanioka et al and Yoshinaga et al disclose an image including symbols, patterns, or identification marks. In the combination, the second section comprises words and symbols.

Claims 4, 8, 15, 22, 29, and 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanioka et al and Yoshinaga et al, with or without Crandall, as applied respectively to claims 3, 7, 14, 21, 28, 31, and 35 above, and further in view of well known prior art (Official Notice).

Referring to claim 4:

Printed documents such as a card having visible and invisible information are well known in the prior art. It would have been obvious to one of ordinary skill in the art to have further modified Tanioka et al to embed information in such a card in order to apply the invention to personal ID or authentication cards.

Referring to claims 8, 15, 22, 29, 36:

Using invisible ink to print an invisible bar code or optical character recognition text is well known in the prior art. . It would have been obvious to one of ordinary skill in the art to have further modified Tanioka et al to have printed such a code or character

with invisible ink in order to provide unobtrusive security, identification, or tracking marks or information which are machine readable, providing the advantages of rapid, reliable, and accurate machine recognition and processing.

Referring to claim 30:

While Tanioka et al and Yoshinaga et al do not disclose the fluorescent inks differ in ultraviolet wavelengths at which they fluoresce, wherein the system classifies the key information based on the wavelengths, classifying key information in documents based on different response in ultraviolet wavelengths is well known in the prior art.

It would have been obvious to one of ordinary skill in the art to have further modified Tanioka et al and Yoshinaga et al to have included such well known classification of key information in documents based on different response in ultraviolet wavelengths in order to enable discrimination different types of key information and thereby improve and expand applications of the system.

Referring to claims 31-33:

Tanioka et al and Yoshinaga et al disclose everything in claims 31-33 as discribed above with respect to claim 23 except for a print head system adapted to print at least two different inks on the document, a controller for controlling application of the first and second inks by the print head system on the document, wherein the print head system comprises at least two print heads or the print head comprises a single print head adapted to pass by an area on the document at least two times. However, such print heads and a print head controller are well known in the prior art.

It would have been obvious to one of ordinary skill in the art to have further modified Tanioka et al and Yoshinaga et al to have included such a print system in order to produce documents which can be used in their key information extraction system, thereby providing a syatem with a wider capability and wider application.

Referring to claim 34:

Tanioka et al disclose the first and second sections each comprise a black color ink. See col. 6, lines 9-27.

Referring to claim 35 and 37:

Yoshinaga et al disclose the feature using a plurality of different fluorescent inks for the identification mark or key information (the second section), wherein the second section thus comprises invisible ink forming the non-visualized identification mark or key information. See abstract and col. 2, lines 21-30.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/692,569 in view of Yoshinaga et al, Crandall, and well known prior art. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims differ from the claims of this application only in a manner which is obvious for the same reasons as explained above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Cited Art

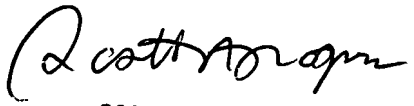
The art made of record and not relied upon is considered pertinent to applicant's disclosure. There are many references cited that show the state of the art with respect to methods and systems for producing and scanning documents having invisible ink as well as the documents per se. Note, Morton et al (US 5642442 A) disclose using two types of fluorescent ink for two different fiduciary markings to provide the orientation of the underlying text in an OCR application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Rogers whose telephone number is 571-272-7467. The examiner can normally be reached Monday through Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Coles can be reached at 571-272-7402.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC2600 Customer Service at 571-272-2600. Official correspondence by facsimile should be sent to 571-273-8300. The USPTO contact Center phone numbers are 800-PTO-9199.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SCOTT ROGERS
PRIMARY EXAMINER

8 June 2007